

Notice of Allowability

Application No.

10/783,109

Examiner

Emily Bernhardt

Applicant(s)

CHILDERS ET AL.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to ____.
2. ☒ The allowed claim(s) is/are 1-13.
3. ☐ The drawings filed on ____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 2/20/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 07/21/04.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other ____.

E Bernhardt
Emily Bernhardt
Primary Examiner
Art Unit: 1624

REASONS FOR ALLOWANCE/EXAMINER'S AMENDMENT

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-13, drawn to compounds of formula (I), classified in class 544, subclasses 295, 380 based on the working examples.
- II. Claim 14, drawn to multiple neurodegenerative diseases employing compounds of I, classified in class 514, subclasses various.
- III. Claims 15-17, drawn to multiple neurodegenerative disorders employing compounds of I and additional compounds, classified in class 514, subclasses various.
- IV. Claims 18-19, drawn to treating pain employing compounds of I and additional compounds, classified in class 514, subclasses various.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP ' 806.05(h)). In the instant case more than

one use exists as evidenced by the many being claimed as well as additional uses suggested by the art applied in parent.

Uses in III and IV employ compounds of broader scope than in I. Thus art which may anticipate or render obvious one of these uses would not necessarily do so for compounds within I limited to a much narrower scope.

During a telephone conversation with Ms.Hild on 7/12/04 a provisional election was made with traverse to prosecute the invention of I, claims 1-13. Claims 14-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Upon review of elected subject matter it is noted that the claims have been narrowed to exclude the subject matter rendered obvious over Abou-Gharbia (US'552) in view of Cliffe (US'278), namely where $m=0$ and $R_1=\text{phenyl}$ in parent which has been appealed. Instant claims do not permit " R_1 " phenyl to be directly

attached to carboxamide chain and thus the 103 rejection, affirmed by the Board in parent, is not pertinent herein. Thus claim 14 can be rejoined in view of Rules for Rejoinder as set forth in "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. 1 103(b)", 1184 O.G. 86 (March 26, 1996). However, the claim would need to be examined for compliance with 35 USC 112. In order to pass the case to issue at this time, Ms. Hild on 7/21/04 authorized the cancellation of all nonelected subject matter reserving the right to file divisional cases on the nonelected subject matter. This will be done via an Examiner's Amendment as set forth below.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

1. Cancel claims 14-19.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is (571) 272-0664.

If attempts to reach the examiner by phone are unsuccessful, the supervisor for AU 1624, Dr. Mukund Shah, can be reached at (571)272-0674.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


EMILY BERNHARDT

PRIMARY EXAMINER

Group 1600